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| 09/687,149      | 10/12/2000  | John J. Sie          | 19281-000900US      | 8623             |

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EXAMINER

BROWN, RUEBEN M

ART UNIT PAPER NUMBER

2611

DATE MAILED: 02/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 1 of the present application, 09/687,149 hereinafter referred to as ‘149 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 & 20 of copending Application No. 09/687,148, hereinafter referred to as ‘148, in view of Garfinkle, (U.S. Pat # 5,530,754). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1 & 20 of the amended ‘148 application contains all of the elements of the present application, ‘149.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Considering claim 1 of the present application, the claimed method for distributing programming, the method comprising:

‘transmitting a first set of programs in real time according to a schedule of programming’ and ‘storing a second set of programs on a server, at least one of the first set of programs having a counterpart in the second set of programs’, is recited verbatim in claim 1 of the ‘148 application.

The amended claimed feature of, ‘located on a set-top box local to a user’ is recited verbatim in claim 20 of the ‘148 application. The additionally amended claimed feature of ‘wherein the counterpart in the second set of programs is substantially identical to the at least one of the first set of programs’ is also recited verbatim in the amended claim 1 of the ‘148 application.

The further claimed feature of ‘playing at least one of the second set of programs from the server under the control of the user’, corresponds directly with the feature recited in claim 1 of the ‘148 application, which reads ‘each of which is configured to be played for a user under the user’s playback control’.

Therefore the claims 1 & 20 of the '148 application contains all of the elements of claim 1 of the present application, '149. However, claim 1 of the '148 includes the additional feature, not recited in the claim 1 of the '149 application, namely, 'transmitting a notification signal to distinguish at least one of the second set of programs on the server from programs not on the server'.

Examiner turns to Garfinkle, which is in the same field of endeavor, which provides a teaching of storing a lead-in segment of movies at a local set-top box, which corresponds with the claimed 'second set of programs on a server located on a set-top box, local to a user". Garfinkle goes on to teach that along with the listing of video products, there is an indication also transmitted, which indicates whether a particular movie stored in the video product store 12 has a corresponding lead-in or trailer also stored in the catalog memory store 22/product store 24, see col. 3, lines 40-64 & col. 4, lines 1-64. It would have been obvious for one of ordinary skill in the art the time the invention was made, to modify claim 1 of the '149 application, with the teachings of Garfinkle indicating whether a particular movie from the menu catalog has a lead-in segment stored on the local user's set-top box, at least for the desirable advantage of informing the instant user of which movies from the video product store 12 have a lead-in or trailer downloaded and stored at the user's set-top box.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Ismail, (U.S. Pat # 6,614,987).

Considering claim 1, the claimed method for distributing programming, the method comprising:

‘transmitting a first set of programs in real time according to a schedule’, is met by the disclosure of Ismail that the system broadcasts regular TV programs to viewers, see col. 3, lines 18-31; col. 9, lines 60-66; col. 10, lines 15-20, which discusses subscribers choosing particular broadcast programming based on channel and/or time of broadcast.

‘storing a second set of programs on a server located on a set-top box local to a user, such that at least one of the first set of programs have a counterpart in the second set of programs, wherein the counterpart in the second set of programs is substantially identical to the at least one

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of the first set of programs', is met by the disclosure in Ismail that the system records a plurality of broadcast programs in a subscriber equipment, based on one or more of a subscriber's direct selection; a profile generated based on inferences taken from the instant subscriber's viewing preferences and/or category-value pairs given to programs that match category-value pairs specified by the user, see col. 3, lines 9-20; col. 3, lines 65-67 thru col. 4, lines 1-34; col. 6, lines 18-52; col. 10, lines 3-31.

'playing at least one of the second set of programs from the server under the control of the user', reads on the discussion in Ismail that the subscriber can control the playback of broadcast programs recorded on the subscriber equipment, using VCR-like functions, col. 3, lines 20-30; col. 13, lines 50-67 thru col. 14, lines 1-18.

Considering claim 2, the claimed feature of 'switching from transmission of a particular program according to a schedule of programming to transmission of a counterpart to the particular program from the server', reads on the discussion in Ismail that when a subscriber is watching a currently broadcast program, that the subscriber has the option of recording the instant currently broadcast program onto the subscriber equipment (for instance, in order to watch a different program), see col. 13, lines 50-67. When the instant subscriber desires to view the broadcast program that was previously being viewed, that instant program can be optionally replayed from its recording on the subscriber equipment. Thus Ismail teaches switching from the transmission of a broadcast program, to its counterpart stored on subscriber equipment.

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Considering claims 3-4, the disclosure of Ismail teaches that the switching is executed optionally based on the subscriber's command, which begins playing of the recorded program, col. 13, lines 50-67 thru col. 14, lines 1-7.

Considering claim 5, the claimed subject matter reads on the discussion in Ismail, that when the resume button is pressed, the system begins playing the recorded program from the point at which the currently broadcast program was paused, see col. 13, lines 60-67 thru col. 14, lines 1-7.

Considering claims 6-7, see col. 14, lines 8-20. Ismail teaches the use of a remote control, col. 13, lines 61-67.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 8, 11 & 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ismail, in view of Garfinkle, (U.S. Pat # 5,530,754).



Considering claims 8 & 11, even though the subscriber in Ismail is able to select programs that are stored on the subscriber equipment, the reference appears to merely teach that the access the program by changing channels, instead of by interacting with a 'menu of programs', as claimed. Nevertheless, Garfinkle which is in the same filed of endeavor, teaches that set a set of programs from a remote server may be stored at a subscriber equipment, and that a menu or catalog may also be supplied to the subscriber in order to select the desired program, col. 3, lines 5-55. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Ismail with the feature of transmitting a menu of programs stored at the subscriber equipment as taught by Garfinkle, at least for the well-known improvement of assisting the user program selection (col. 3, lines 54-57), using a program guide instead of the user checking each channel individually by changing the channel.

Considering claims 13-14, in Ismail (col. 3, lines 9-30) & Garfinkle (col. 4, lines 12-25) the at least one of the second set of programs can be played form its beginning, which reads on the claimed subject matter.

7. Claims 9-10 & 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ismail, in view of Garfinkle as applied to claims 8 & 11 above, and further in view of Edwards, (U.S. Pat # 5,604,528).

Considering claims 9-10 & 12, Garfinkle does not discuss the claimed feature of verifying whether a user is authorized to access programs from a server. However Edwards,

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which is in the same filed of endeavor of VOD or pay-per-view services, teaches having CATV subscribers in at least two categories, with respect to premium channels, namely, regular subscription and periodic subscription. The subscribers with a periodic subscription are generally denied access to the premium channels, unless they sign up for a period of time, such as the weekend, or they are granted a promotional free period, Abstract; col. 4, lines 11-40; col. 10, lines 11-67 & col. 11, lines 1-40. Therefore, Edwards reads on determining whether a subscriber is authorized to access content; also see col. 18, lines 1-15. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Ismail & Garfinkle with the feature of verifying user authorizations to access content, for the known purpose of ensuring that proper payments and are authorizations are given, before access to certain content, such as premium channels is provided to a particular user; see col. 1, lines 41-60; col. 2, lines 37-67.

8. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ismail as applied to claim 1 above, and further in view of Edwards.

Considering claim 15, Ismail does not discuss the claimed feature of verifying whether a user is authorized to access programs from a server. However Edwards, which is in the same filed of endeavor of VOD or pay-per-view services, teaches having CATV subscribers in at least two categories, with respect to premium channels, namely, regular subscription and periodic subscription. The subscribers with a periodic subscription are generally denied access to the premium channels, unless they sign up for a period of time, such as the weekend, or they are granted a promotional free period, Abstract; col. 4, lines 11-40; col. 10, lines 11-67 & col. 11,

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lines 1-40. Therefore, Edwards reads on determining whether a subscriber is authorized to access content; also see col. 18, lines 1-15. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Ismail with the feature of verifying user authorizations to access content, for the known purpose of ensuring that proper payments and are authorizations are given, before access to certain content, such as premium channels is provided to a particular user; see col. 1, lines 41-60; col. 2, lines 37-67.

9. Claims 18-20 & 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ismail, in view of Payton, (U.S. Pat # 5,790,935).

Considering claim 18, the claimed steps of a method for distributing programming that correspond with subject matter mentioned above in the rejection of claim 1 is likewise analyzed. Claim 18 includes the additionally recited feature of 'detecting a request from the user for program control over one of eth programs in the first set of programs; determining whether the requested program has a counterpart program stored on the server'. Ismail teaches detecting when the subscriber requests a control of a currently broadcast program, such as Pause, see col. 13, lines 50-60. Ismail responds by in fact Pausing the currently broadcast program and storing the instant currently broadcast program on the subscriber's equipment, so that it may accessed when desired by the subscriber. However, Ismail does not explicitly state that he system would 'determine if the requested program is already stored on the local server'.

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Nevertheless, Payton, which is in the same field of endeavor of local storage of programming, teaches that a set of programs maybe broadcast and stored on the local storage. When the subscriber attempts to access a program, the system first checks to see if the program is stored on the local server, Fig. 3b. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Ismail with the feature determining whether a requested program is already stored on a local storage device, at least fro the improvement of reducing the amount of necessary two-way traffic, as taught by Payton, see col. 6, lines 20-35; col. 7, lines 11-35.

Considering claim 19, both Ismail & Payton include a wireless remote control.

10. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ismail & Payton as applied to claim 18 above, and further in view of Edwards.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A) Russo Local storage of a plurality of programs to be accessed as desired by a user.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Reuben M. Brown whose telephone number is (571) 272-7290. The examiner can normally be reached on M-F (9:00-6:00), First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on (571) 272-7294. The fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300 for regular communications and After Final communications.

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Reuben M. Brown

  
**REUBEN M. BROWN**  
**PATENT EXAMINER**